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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,627	06/09/1999	SWARUP ACHARYA	ACHARYA2-5-7	7063

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EXAMINER

MEKY, MOUSTAFA M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 05/28/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary

Application No.

09/328,627

Applicant(s)

ACHARYA ET AL.

Examiner

Moustafa M Meky

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8, 27-38, 42, 45-47 and 50-75 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☒ Claim(s) 5-8, 27-38, 42, 45-47 and 69-75 is/are allowed.

- 6) ☒ Claim(s) 50, 51, 53, 64 and 65 is/are rejected.

- 7) ☒ Claim(s) 52, 54-63, 66-68 is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The amendment filed 4/22/2003 has been entered and considered by the examiner.

2. Claims 5-8, 27-38, 42, 45-47, and 50-75 are presenting for examination.

3. Claims 5-8, 27-38, 42, 45-47, 69-75 are allowed over the prior art of record.

3.1. The prior art of record does not teach the following limitations:

* transmitting to a server, responsive to receiving a request for transmission a target file from a client (user), a request for transmission of a materialized parent file from which a user-selected version (another version) may be derived by conversion (claims 5 & 69);

* generating at a client, a menu of user-selectable versions of target file in response to selecting at the client, a hyperlink that is a single point of access to a target file in which at least one user-selectable version being derivable by conversion from a materialized version (claim 27);

* requesting from a server computer a materialized parent version of a target file from which a user-selected version can be derived if such a version is not stored on a proxy computer, deriving the user-selected version from the parent version by conversion, and transmitting the user-selected version (claim 42);

* receiving from a server, at a proxy computer, a materialized file, deriving by conversion of the file at the proxy computer, a derived version, and transmitting the derived version (claim 73).

(the examiner advices the applicant to fix the last limitations of claim 73 in which the transmitting part should be from the proxy computer to a requesting computer and/or a client for a derived version).

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 50-51, 53, 64-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Rose (US Pat. No. 6,085,199).

6. As to claims 50-51 & 53, Rose shows in Figs 3 & 7, a system for communicating between computers interconnected by a network. Rose discloses the limitations of receiving a client's request for transfer of a file having a particular informational content (user selected version of a target file), identifying the parent file of the requested file, deriving by conversion the user selected version and transmitting the selected version of the file to the client, see the abstract, col 2, lines 8-17, col 4, lines 19, 21, lines 29-44, lines 66-67, col 5, lines 1-16.

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7. As to claims 64-65, the claims are similar in scope to claims 50-51, and they are rejected under the same rationale.

Therefore, it can be seen from paragraphs 6-7 that Rose anticipates claims 50-51, 53, 64-65.

8. Claims 50-51, 53, 64-65 are rejected under 35 U.S.C. 102 (a) & (e) as being anticipated by Hunt (US Pat. No. 5,764,235).

9. As to claims 50-51, 53, Hunt shows in Figs 1A & 2, a system for communicating between computers interconnected by a network. Hunt discloses the limitations of receiving a client's request for transfer of a file having a particular informational content (user selected version of a target file), identifying the parent file of the requested file, deriving by conversion the user selected version and transmitting the selected version of the file to the client, see col 2, lines 31-43, col 3, lines 1-12, col 4, lines 63-67, col 5, lines 1-6, col 9, lines 38-42, col 10, lines 6-10, col 11, lines 3-13, col 13, lines 41-47.

10. As to claims 64-65, the claims are similar in scope to claims 50-51, and they are rejected under the same rationale.

Therefore, it can be seen from paragraphs 9-10 that Hunt anticipates claims 50-51, 53, 64-65.

11. Claims 52, 54-63 & 66-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11.1. The prior art of record does not teach the following limitations:

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* the default setting is specified by a proxy for relaying a communication between a sender and a receiver (claims 52 & 66);

* transmitting the parent file from the server to a proxy and the proxy derives the derived version (claim 54);

* the deriving step is performed at a proxy for relaying a communication between a sender and a receiver (claim 67).

12. The applicant argues in his remarks regarding claims 50 & 64 about limitations that are not within the claimed language. Clearly all the limitations of claims 50-51, 53 & 64-65 are being shown by both Rose and Hunt as been discussed above.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Moustafa M. Meky whose telephone number is (703) 305-9697.

The examiner can normally be reached on week days from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The fax number for the After-Final correspondence/amendment is (703) 746-7238. The fax number for official correspondence/amendment is (703) 746-7239. The fax number for Non-official draft correspondence/amendment is (703) 746-7240.

M.M.M

May 24, 2003


MOUSTAF A M. MEKY
PRIMARY EXAMINER